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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Dimitri Philippou

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EXAMINER

AFTERGUT, JEFF H

ART UNIT

PAPER NUMBER

1746

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/549,808	<b>Applicant(s)</b> PHILIPPOU, DIMITRI	
	<b>Examiner</b> Jeff H. Aftergut	<b>Art Unit</b> 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34,36,37,39-45,47-57,60-70 and 72-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34,36,37,39-45,47-57,60-70 and 72-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9-28-10</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility.

An invention that is “inoperative” (i.e., it does not operate to produce the results claimed by the patent applicant) is not a “useful” invention in the meaning of the patent law. See, e.g., *Newman v. Quigg*, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); *In re Harwood*, 390 F.2d 985, 989, 156 USPQ 673, 676 (CCPA 1968) (“An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful.”).

Situations where an invention is found to be “inoperative” and therefore lacking in utility are rare, and rejections maintained solely on this ground by a Federal court even rarer. In many of these cases, the utility asserted by the applicant was thought to be “incredible in the light of the knowledge of the art or factually misleading” when initially considered by the Office. *In re Citron*, 325 F.2d 248, 253, 139 USPQ 516, 520 (CCPA 1963). Other cases suggest that on initial evaluation, the Office considered the asserted utility to be inconsistent with known scientific principles or “speculative at best” as to whether attributes of the invention necessary to impart the asserted utility were actually present in the invention. *In re Sichert*, 566 F.2d 1154, 196 USPQ 209 (CCPA 1977). However cast, the underlying finding by the court in these cases was that, based on the factual record of the case, it was clear that the invention could not and did not work as

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the inventor claimed it did. Indeed, the use of many labels to describe a single problem (e.g., a false assertion regarding utility) has led to some of the confusion that exists today with regard to a rejection based on the “utility” requirement. Examples of such cases include: an invention asserted to change the taste of food using a magnetic field (*Fregeau v. Mossinghoff*, 776 F.2d 1034, 227 USPQ 848 (Fed. Cir. 1985)), a perpetual motion machine (*Newman v. Quigg*, 877 F.2d 1575, 11 USPQ2d 1340 (Fed. Cir. 1989)), a flying machine operating on “flapping or flutter function” (*In re Houghton*, 433 F.2d 820, 167 USPQ 687 (CCPA 1970)), a “cold fusion” process for producing energy (*In re Swartz*, 232 F.3d 862, 56 USPQ2d 1703, (Fed. Cir. 2000)), a method for increasing the energy output of fossil fuels upon combustion through exposure to a magnetic field (*In re Ruskin*, 354 F.2d 395, 148 USPQ 221 (CCPA 1966)), uncharacterized compositions for curing a wide array of cancers (*In re Citron*, 325 F.2d 248, 139 USPQ 516 (CCPA 1963)), and a method of controlling the aging process (*In re Eltgroth*, 419 F.2d 918, 164 USPQ 221 (CCPA 1970)). These examples are fact specific and should not be applied as a per se rule. Thus, in view of the rare nature of such cases, Office personnel should not label an asserted utility “incredible,” “speculative” or otherwise unless it is clear that a rejection based on “lack of utility” is proper.

Applicant defines in broad terms a system of assembling via molecular and/or sub-atomic manufacturing of an object defined by signals from a transmission means which transmits the signals provided by at least one input means. There is no example provided in the disclosure as to how one could usefully make an object defined by signals, sub-atomic particles, atomic particles and impulses of energy which are

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transmitted via a transmission means from an input means. It simply is not deemed physically possible to manufacture an object from transmitted signals as defined. The subject matter courts have found to be outside of, or exceptions to, the four statutory categories of invention is limited to abstract ideas, laws of nature and natural phenomena. Here the applicant is claiming an abstract idea to replicate matter and/or transport matter from one local to another which is just that, an abstract idea which is not entitled to patenting as it does not satisfy the requirements of being one of statutory subject matter.

It is clear that one cannot possibly assemble with at least one output means by at least one assembly means selected from the group comprising molecular, subatomic and impulses of energy which receive these elements from the transmission means and are capable of manufacturing an object from the molecular, sub-atomic, or impulses of energy. In other words, assembly of an object from impulses of energy, subatomic particles, and impulses of energy which are inputted and supplied to a transmission means is simply not physically possible in the manner described. It is that of science fiction which relates to replication from energy alone. The claimed invention lacks utility as the claimed process is not physically possible to perform.

It should be noted that claim 43 (which defines the locations to be different in “time periods”, “parallel worlds” and “time quadrants”) is clearly not possible.

The applicant has provided various articles which suggest that quantum teleportation is feasible. It should be noted that this “teleportation” relates solely to the teleportation of the characteristics (like spin) of a photon from a photon in one location

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to a photon in another location and NOT to the teleportation of an object. In fact of matter, the photon already exists at both locations, what is "teleported" is the spin or rotation upon the photon. Applicant is advised that this is a far cry from the transportation of another object from a seller to a buyer. Note that the assembly via the quantum teleportation does not include a disassembly means as the photon is in no way disassembled at the site of the seller. Furthermore, there is no real assembly which takes place at the site of the buyer for an object to be sold as the original disclosure clearly never intended to buy and sell the spin of the photon. Additionally note that the disclosure makes no reference whatsoever to the specific means for teleporting matter from one location to another so that a seller can transport the object to the buyer. The applicant is advised that the disclosure as filed (and as in possession of applicant at the time of filing) would not have led one to look to quantum teleportation as the means for breaking down the object at one location and assembling the object at a second location. While this may be possible for a photon, it is speculative at best that it is feasible for an object intended to be a part of commerce. The article submitted by applicant merely show that it was possible through "entanglement" to pass information (transport) regarding the state of one photon onto another photon which is physically separated from the other photon. This is by no means disassembly of an object at one location followed by assembly of the object based upon the information provided via the disassembly particularly given the fact that the photon was present in both locations prior to the disassembly and assembly operation. Note that the article entitled "Teleportation Works-but not for Scotty" the reference makes clear that researchers

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have repeatedly transported quantum information but have never been able to transport a single atom. Clearly, to actually disassemble an object that a seller has and reassemble the same for a buyer at a different location is not physically possible at this time.

It should additionally be clear that claim 43 lacks utility as it certainly cannot be possible to pass information to parallel worlds and/or to different time quadrants or time periods.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As discussed above, the assembly system proposed by applicant simply is not capable of functioning in the manner described. One cannot make an object of matter from subatomic or atomic particles and/or impulses of energy which are inputted and transmitted from one local to another to make matter. There are no known ways in which matter can be created from energy. Additionally the manner of transmitting and inputting the atomic and subatomic particles is not described in any meaningful manner

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to make it so that one can make and/or use the invention in the manner described.

There are simply no examples described in the disclosure which would have provided evidence that the claimed operation was physically possible. It should be noted that claim 43 (which defines the locations to be different in “time periods”, “parallel worlds” and “time quadrants”) is clearly not possible.

***Claim Rejections - 35 USC § 102/103***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 34, 36, 37, 39-45, 47-57, 60-70, 72-75 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sternbach et al (the portions from “Star Trek Then Next Generation Technical Manual”).

Not only did Sternbach et al suggested that one skilled in the art would have replicated food in a food replicator from input and signals which directed an assembly means to replicate food based upon the signals and transmission means to create the



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same, the reference additionally suggested that teleportation means was known which included transportation of objects and individuals in what is referred to as a transporter.

The reference suggested that one skilled in the art would have additionally included a disassembly means within the system which disassembled the object at one location and sent the object via subatomic particles to another location where the object was recreated based upon the information retained relating to the signals created in the system. Inasmuch as quantum teleportation is enabled (as noted by applicant in the reply), it is clear that one viewing Sternbach et al would have been able to teleport an object from one location to another. Additionally as it was well known in a cafeteria that food is provided by a seller to a buyer who then consumes the food, the food replication system clearly teleported the food from a seller to a buyer. It should additionally be noted that there is nothing in the claims as presented that is not performed by Sternbach et al in the mere teleportation of material from one location to another and additionally it was known to transfer material from a seller to a buyer with various transportation means when a sale of material or objects takes place. It certainly would have been within the purview of the ordinary artisan to employ the transporter to teleport the items being bought and sold in the ordinary course of commerce using the teleportation system of Sternbach et al. Note that inasmuch as applicant's arrangement is enabled, the transporter of Sternbach et al is enabled.

***Response to Arguments***

7. Applicant's arguments filed 9-28-10 have been fully considered but they are not persuasive.

As noted above, while quantum teleportation may be physically possible, it does not in any way enable the teleportation of an object from a seller to a buyer. Note even the information applicant submitted evidenced that it was not possible to teleport an object but rather the information related to the spin of a photon of an atom. No atoms are actually teleported, only the spin or arrangement of the same in a particle which pre-exists at the other local. It should be noted that this is clearly not what was described in the disclosure (there is no mention whatsoever of teleportation of the spin of a particle for the purpose of selling such spin at the location of a buyer. Applicant was clearly not in possession of the same at the time the invention was made nor did applicant describe in any meaningful way how to make and/or use this information to sell to a buyer the spin of an atom.

No claims are allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Jeff H. Aftergut/ whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:30-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on 571-272-1127. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff H. Aftergut/  
Primary Examiner  
Art Unit 1746

JHA  
December 5, 2010